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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,465	08/23/2001	John R. Milton	10010979-1	4080

7590 04/21/2005

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/938,465	MILTON, JOHN R.
	Examiner	Art Unit
	Jean M Corrielus	2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 22 and 23 is/are allowed.
- 6) Claim(s) 1-3,5-10,12-17 and 19-21 is/are rejected.
- 7) Claim(s) 4,11,18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed on February 8, 2005, in which claims 1-23 are presented for further examination.

Response to Arguments

2. Applicant's arguments filed on February 8, 2005 have been fully considered but they are not persuasive. (See examiner remark).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 4-10, 12-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrel et al (hereinafter "Ferrel") US Patent no. 5,907,837, Krishna et al., (hereinafter "Krishna") US Patent no. 6,012,071 and Daniel US Patent Publication no. 2003/0163784.

As to claim 1, Ferrel discloses the claimed "detecting at least one placement tag with the content element in a computer system, the content element comprising at least a portion of a content item to be placed in the publication" retrieving content from the publication and the layout that satisfy user query (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52). However, Ferrel does not explicitly discloses the use of

“determining at least one position in the publication at which the content element is placed when the at least one placement tag is detected”. Krishna discloses an analogous electronic publishing system that employs servers to store electronic publication. In particular, Krishna discloses the claimed “determining at least one position in the publication at which the content element is placed when the at least one placement tag is detected” (col.10, lines 61-67; col.11, lines 1-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of the cited references. One having ordinary skill in the art would have found it motivated to utilize such a combination would allow Ferrel’s system the enhanced capability of finding the location of content in the publication, thereby providing easy access the content of interest.

Neither Ferrel nor Krishna discloses the use of generating a placement report that logs the at least one position of the content element within the publication. On the other hand, Daniel discloses the claimed “generating a placement report that logs the at least one position of the content element within the publication” (page 8, paragraph [0078]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching the teaching of the cited references. One having ordinary skill in the art would have found it motivated to utilize such a combination would allow Ferrel and Krishna’s system the enhanced capability of generating a report as to where the content item placed in the publication, thereby the content element of the publication can be easily arranged, updated and deleted without having to make any changes to the remainder of the publication.

As to claim 2, Ferrel discloses the claimed “placing the content item in the at least one position in the publication” (col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claim 3, Daniel discloses the claimed “identifying a placement report identifier associated with the at least one placement tag “ and “writing the placement report identifier to the placement report (page 8, paragraph [0078]).

As to claim 5, Ferrel discloses the claimed “drawing an association between the at least one placement tag and the content element” (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claim 6, Ferrel discloses the claimed “identifying the at least one placement tag as an attribute associated with the content element” (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claim 7, Ferrel discloses the claimed “identifying the content element encapsulated between a pair of placement tags” (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claims 8-10, 12-17 and 19-21, the limitations of claims 8-10, 12-17 and 19-21 have been detailed in the rejection of claims 1-3 and 5-7 above. They are, therefore, rejected under the same rationale.

Allowable Subject Matter

5. Claims 4, 11 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for Indicating Allowable Subject Matter

6. Upon searching a variety of databases, the examiner respectfully submits that claims 22 and 23 are allowable in light of the Applicants arguments and in light of the prior art made of record.

Remark

(A). Applicants asserted that cited references fail to show or suggest each of the elements of claims 1-23. In particular, Applicants asserted that asserted that the cited combination references do not show or suggest that the use of determining a position in the publication at which a content element has already been placed when the at least one placement tag is detected that is associated with the content element and Daniel does not show or suggest the concept of generating a placement report that logs the at least one position of the content element within a given publication. The examiner disagrees with the precedent assertion. The examiner kindly submits that the appellant misread the applied references. However, when read and analyzed in light of the specification, the invention as claimed does not support applicants' assertions. Actually, applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejection. The aforementioned assertion wherein Krishna

fails to teach applicant's claimed element "determining a position in the publication at which a content element has already been placed when the at least one placement tag is detected that is associated with the content element", was unsupported by objective factual evidence and was not found to be substantial evidential value. Krishna, however, discloses a client server system for storing publication data and defining a layout of the electronic publications and the position where the publication is located and how to locate the content of information (elements) in each of the plurality of regions. Furthermore, Daniel combines with Krishna discloses the use of generating a report at the appropriate location where the publication has been stored in order to allows Krishna' system the enhanced capability of setting the right price fro the publication. The combination of the cited references substantially the invention as claimed. It is important to applicants do not provide convincingly evidence to show how the examiner's references used in the rejection do not meet the claims language. Furthermore, applicants are reminded that 37 CFR 1.111(b) states, "a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirement of this section". Thus, applicants' assertions are just mere allegation with no supported fact by failing to specifically point out how the language of the claims patentably distinguished them from the cited references. Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969). Hence the 35 U.S.C 103 is hereby sustained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M. Corrielus
Primary Examiner
Art Unit 2162

April 8, 2005